

**REMARKS**

Claims 1 and 9-16 remain pending in this application. Claims 1 and 9-14 are rejected. Claims 2-8 are previously cancelled. New claims 15 and 16 are added. Claim 1 has been amended for formalistic reasons.

Claim 1 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Pub. No. 2004/0005937 (Saiz) in view of U.S. Patent No. 2,135,210 (Farrar). To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03.

The Office Action states that Saiz discloses a golf ball with a groove having the claimed depth. Claim 1 recites a groove depth of 1/8 of a diameter of the golf ball. Saiz fails to disclose or suggest a groove depth of 1/8 of a diameter of the golf ball.

The Office Action admits on page 2 that Saiz does not have the claimed width of the groove and relies on Farrar for this teaching. However, Farrar fails to disclose or suggest any groove width selected among 1/3, 1/4, and 1/8 of a diameter of the golf ball, as claimed in claim 1. Accordingly, the cited art fails to disclose or suggest at least two limitations of claim 1 and it is therefore respectfully requested that claim 1 be allowed.

Claim 1 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Pub. No. 2004/0005937 (Saiz) in view of U.S. Patent No. 6,852,039 (Pettigrew

et al.). Applicant believes that the reference to claim 1 is a typographical error and that the Examiner intended to list claims 9-14. Also, the Office Action did not mention Farrar in this particular rejection. If the Examiner intended to include Farrar in this particular rejection, the arguments presented below apply equally to a rejection that includes Farrar as one of the references.

The Office Action states that it would be obvious to include indicia on the golf ball of Saiz in view of Pettigrew et al. On page 3, the Office Action states that Saiz fails to teach the use of a logo, number, symbol, and slogan printed on the groove and relies on Pettigrew et al. for this teaching.

The Office Action states that Pettigrew et al. uses indicia on a golf ball and that because the indicia recited in the claims of the current application merely depend on the intended use of the device and the desired information to be displayed that it would be obvious to provide the claimed indicia on a golf ball. The Office Action also states that the markings are not functionally related to the golf ball of the current application and that therefore there is no unobvious functional relationship.

Pettigrew et al. has claims which recite instructions for hitting a golf ball printed on the golf ball. Thus, if information on a golf ball pertaining to the intended use of the golf ball and the desired information to be displayed are per se obvious, then, for example, claim 1 of Pettigrew et al. would be per se invalid. The Notice of Allowability of Pettigrew et al., in the section of Allowable Subject

Matter, states that the reasons for allowance are that "the prior art does not show or suggest the instructional indicia being text and indicated [sic] the point at which the ball should be struck." Applicant respectfully requests that the Examiner explain why the claims in Pettigrew et al. were allowed by the USPTO while, at the same time, the Examiner is suggesting that information on a golf ball pertaining to the intended use of a golf ball and the desired information to be displayed is per se obvious.

Furthermore, the Office Action provides no evidence that information on a golf ball pertaining to the intended use of a golf ball and the desired information to be displayed is per se obvious and Applicant respectfully requests that the Examiner cite appropriate case law in order for Applicant to provide an appropriate response. Additionally, the Federal Circuit has stated that "[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." *In re Gulack*, 217 USPQ 401, 403 (Fed. Cir. 1983). Thus, one of a logo, number, symbol, and slogan printed on the groove of a golf ball, as recited in claims 9-14 is nonobvious.

Claims 9 and 13 recite at least one of a logo, number, symbol, and slogan on a groove. All of the indicia in Pettigrew et al. are located on the outer surface of the body, as stated in the abstract of Pettigrew et al. There is no suggestion or motivation evidenced in the Office Action for indicia to be on a groove which completely circumscribes said golf ball. Furthermore, locating the indicia on the

groove as opposed to the outer surface of the golf ball will advantageously reduce the wear on the indicia. Accordingly, at least one of a logo, number, symbol, and slogan being on a groove is a functional relationship and is patentable.

Claims 11 and 13 recite at least one of a logo, number, symbol, and slogan being indicative of the width of the groove. An analysis of *In re Gulack*, which was cited by the Office Action, supports the proposition that there is a functional relationship between the golf ball and at least one of a logo, number, symbol, and slogan being indicative of the width of the groove of the golf ball. The court in *In re Gulack* analyzed *In re Miller* and quoted *In re Miller* as stating that "[h]ere is a new and unobvious functional relationship between a measuring *receptacle*, volumetric *indicia*, thereon indicating volume in a certain ratio to actual volume, and a *legend* indicating the ratio" and stated that "[t]he court found that the printed matter in Miller's invention was functionally related to the volume measuring device and reversed the rejection." See *In re Gulack*, 217 USPQ 401, 404 (Fed. Cir. 1983). Thus, just as a functional relationship was found between receptacles and indicia on the receptacles pertaining to the volume of the receptacles in *In re Miller* as cited by *In re Gulack*, there is similarly a functional relationship between the golf ball and indicia on the groove of the golf ball pertaining to the width of the groove. The indicia pertaining to the width of a groove is analogous to indicia pertaining to the volume of a receptacle. Thus, as a matter of law, at least one of a logo, number, symbol, and slogan being indicative of the width of the groove in

a golf ball as recited in claims 11 and 13 is functionally related to the golf ball and is therefore patentable. None of the cited art discloses or suggests the subject matter of claims 11 and 13 and notice of their patentability is respectfully requested.

Claim 10 recites that one selected from the logo, number, symbol, and slogan can be seen when the golf ball rolls. The cited art fails to disclose or suggest this limitation.

Claim 12 recites that one selected from the logo, number, symbol, and slogan corresponds a skill level of a golf player. The cited references fail to disclose or suggest this limitation.

Claim 14 recites that the width of the groove is from  $1/8$  to  $1/4$  of a diameter of the golf ball. This limitation is not disclosed or suggested in the cited references. Furthermore, the width of the groove as a function of the diameter of the golf ball has not been demonstrated by the Office Action as being a result-effective variable.

New claims 15 and 16 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Support for new claims 15 and 16 can be found in, for example, Figure 2A, and Figure 3.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

*B* and,

By Ricardo Unikel  
Ricardo Unikel  
Reg. No. 52,309  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340